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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,038	08/29/2003	Michael S. Popovich	13819.71	1541

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CHICAGO, IL 60604-3787

EXAMINER

LOPEZ, MICHELLE

ART UNIT PAPER NUMBER

3721

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/653,038

Applicant(s)

POPOVICH ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/16/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 11-14, and 17-18 of U.S. Patent No. 6,547,120 in view of Popovich et al.

Claim 1 recites a channel for feeding a strip of cartridges to a firing mechanism; a trigger for actuating the firing mechanism, an advancing lever pivotally coupled to the tool, the advancing lever having a strip engagement portion extending into the channel for indexing the strip; an advance link cammingly engaged with the advancing lever and operationally associated with the trigger; the strip engagement portion being in a first position in the channel when the trigger is in the first position, and the strip engagement portion being in a second position in the channel when the trigger is in the second position.

The elements of claim 1 are to be found in claim 1 of the patent, except for a trigger element for actuating the firing mechanism. However, it would have been obvious to one having ordinary skills in the art at the time the invention was made to have provided a powder driven

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fastening tool having a firing mechanism which includes a trigger element for the purpose of actuating the firing mechanism.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 recites the limitation "the sleeve" in the last sentence. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "fine tuning" is indefinite since a "fine tuning" could be any desired adjustment between the trigger and the advance link.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bosch et al. (4,375,269).

Bosch discloses a powder driven fastening tool comprising a channel 17 for feeding a strip of cartridges 15 to a firing mechanism; a trigger 13 for actuating the firing mechanism, the trigger being movable between a first position and a second position; an advancing lever 41 pivotally coupled to the tool, the advancing lever having a strip engagement portion extending

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into the channel for indexing the strip as shown in Figs. 9 and 10; an advance link 47 cammingly engaged with the advancing lever and operationally associated with the trigger via 49 as shown in col. 3; 35-39; the strip engagement portion being in a first position in the channel when the trigger is in the first position as shown in Fig. 9; and the strip engagement portion being in a second position in the channel when the trigger is in the second position as shown in Fig. 10.

With respect to claim 2, Bosch discloses wherein the advance link further comprises a cam pin 51 and the advancing lever further comprises a ramped cam slot, whereby the advancing lever pivots as the cam pin of the advance link follows the ramped cam slot of the advancing lever as shown in Figs. 9 and 10.

With respect to claim 3, Bosch discloses wherein the cam pin 51 is located at a first position along the cam slot when the trigger is in the first position, and wherein the cam pin is located at a second position along the cam slot when the trigger is in the second position as shown in Figs. 9 and 10.

With respect to claim 4, Bosch discloses wherein the advancing lever 41 is pivotally coupled to the tool by a pivot pin 43, whereby the strip engagement portion is disposed on one side of the pivot pin 43 and the advancing lever is cammingly engaged with the advance link on another side of the pivot pin.

With respect to claim 5, Bosch discloses wherein the pivot pin 43 is connected to a housing 1 of the firing mechanism as shown in col. 3; 31-39.

With respect to claim 6, Bosch discloses a firing chamber 7 positioned along the channel between a barrel 3 of the tool and the firing mechanism, the strip engagement portion being positioned toward the firing chamber when the strip engagement portion is in the first position as

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shown in Fig. 9, the strip engagement portion being positioned away from the firing chamber when the strip engagement portion is in the second position as shown in Fig. 10.

With respect to claim 7, Bosch discloses a spring 63 disposed between the trigger 13 and a trigger support of the tool, wherein the spring biases the trigger to the first position, whereby the trigger is movable to the second position against the bias of the spring.

With respect to claim 8, Bosch discloses wherein the strip engagement portion includes a pawl via 55 for inherently engaging with a notch of the cartridge strip.

With respect to claims 9 and 10, it is deemed that the pawl 55 is engaged with a first notch of the cartridge strip when the strip engagement portion is in the first position, and wherein the pawl is engaged with a second notch of the cartridge strip when the strip engagement portion is in the second position (claim 9), wherein movement of said trigger into said second position of said trigger as shown in Fig. 10 moves said pawl into engagement with said second notch of said cartridge strip only when said trigger has been depressed sufficiently to fire said tool.

With respect to claim 13, Bosch discloses a trigger lock preventing depression of said trigger until said tool is cocked as shown in col. 1; 40-44 and 51-63, col. 2; 9-30.

With respect to claim 14, it is deemed that an adjustable connection between trigger 13 and advance link 47 is provided via a trigger extension 49.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosch et al. (4,375,269) in view of Dittrich et al. (6,272,782).

Bosch discloses wherein the advancing lever 41 further comprises a spring 53 as shown in Fig. 6 for biasing the pawl 55, but does not specifically disclose that the pawl is movable into disengagement out of the notch against the bias of the spring (claim 11) wherein the spring is deflected during disengagement of said pawl out of a notch (claim 12).

However, Dittrich teaches a spring 24 biasing a pawl 12, wherein the pawl 12 is movable into disengagement out of a notch against the bias of spring 24 and spring 24 is deflected during disengagement of said pawl 12 out of the notch as shown in Fig. 2 for the purpose of providing a displacing movement of the pawl to advance a strip of cartridge within a feeding channel. In view of Dittrich, it would have been obvious to one having ordinary skill in the art to have provided Bosch's invention with a spring biasing a pawl, wherein the spring is deflected during the disengagement of said pawl out of a notch in order to advance a strip of cartridge.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seghezzi'313, Oesterle'843, Buchel'556, Kershner'952, and Logan'151 are cited to show related inventions.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML

  
JOHN SIPOS  
PRIMARY EXAMINER